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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/683,715	10/10/2003	David S. Benco	LUC-429/Benco 42-31-31-36	2046
32205	7590	11/07/2005	EXAMINER	
CARMEN B. PATTI & ASSOCIATES, LLC ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			DAGOSTA, STEPHEN M	
			ART UNIT	PAPER NUMBER
			2683	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/683,715

Applicant(s)

BENCO ET AL.

Examiner

Stephen M. D'Agosta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10-24-2005 have been fully considered but they are not persuasive.

1. The primary examiner acknowledges the change to the figure and title.
2. The applicant argues the prior art does not teach a comparison being performed during dialing. The primary examiner disagrees for several reasons:
 - a. Snellman anticipates the user's claims since he discloses an embodiment whereby he performs an automatic update prior to dialing (eg. at registration). So, technically, a comparison is not required for this embodiment.
 - b. Snellman teaches several different manners in which the phone numbers are updated. One manner teaches the numbers being updated periodically (page 9, L1-5), thus allowing a user to roam into a new area before an updating period whereby the user has an out-of-date phone number. Then the number would be updated/compared (during a call) per his "automatic" updating function as previously described.
 - c. Further to the point on page 9, L1-5, Snellman teaches updating be performed at "a request from the user". Hence this "request" can be broadly interpreted as either a call to a local operator and/or a call attempt whereby the operator or phone system determines an out-of-date phone number (via a comparison) and then updates the phone number to a local number.
 - d. Snellman discloses over several pages (page 1-2) that it is well known in the art for a user to roam to a different location and need to update their phonebook to local phone numbers (via a manual process). Hence the manner in which the phonebook is updated is not novel, but the fact that the phone number is updated is the novel feature.
 - e. Lastly, Page 3, Last Paragraph to Page 4, 1st paragraph teaches an embodiment whereby the "phone number name" stays the same but the number is replaced with a local number when dialed. For example, if a user has "Emergency" stored as 911 and then roams to a country where emergency is 811, then at the time of dialing, the 811 phone number is used (when the user is in that new country). Hence, at dialing, a comparison is used to determine where the user is located and which number to dial, which again reads on the claim.
3. Further amending is requested to overcome the rejection.
4. The examiner continues to hold the double patenting rejection.
5. The previous rejection has been updated and is attached.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims **so they are no longer coextensive in scope**. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 4-5 **1, 2 6 and 7** provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of copending Application No. 09-815854. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6 and 7 -5 rejected under 35 U.S.C. 102(b) as being anticipated by Snellman WO98/23108.

As per **claims 1 and 3 6**, Snellman teaches a method/apparatus for automatically updating a non-emergency telephone number stored in a wireless handset (abstract teaches stored phone numbers in a mobile device and page 2, 2nd paragraph teaches supporting both emergency and non-emergency numbers, eg. "help, guidance and so on". Page 10, last paragraph to page 11 discusses guidance as a person needing directions to a certain address which is a non-emergency situation) comprising the steps of:

determining a previous non-emergency telephone number corresponding with a prior location of the wireless handset AND storing the previous non-emergency telephone number in a record associated with the wireless handset in a network database (page 3, bottom paragraph, lines 3-4 state "predetermined telephone numbers of various local operators and/or local services are stored into memory of the mobile phone");

determining a current location of the wireless handset (page 7, bottom paragraph teaches the mobile networks keeping track of the mobiles location via HLR/VLR systems);

determining a first non-emergency telephone number corresponding to the current location where the first non-emergency telephone number is to be used by wireless handsets at the current location to seek non-emergency assistance AND comparing the first non-emergency telephone number and the previous non-emergency telephone number AND if the first non-emergency telephone number is different than the previous non-emergency telephone number, transmitting a message containing the first non-emergency telephone number to the wireless handset where the message is a command for the wireless handset to store in its memory the first non-emergency instead of the previous non-emergency telephone number for access by a user of the wireless handset (page 7, 1st four paragraphs discuss a user dialing a phone number and it being changed to a different phone number depending upon the user's location, eg. if in Finland, a "911" call will be changed to a "112" call, and vice versa. **Note** that page 7, 4th paragraph states that the phone number can be changed/updated in memory as well, which reads on the claim – also see page 8, 2nd and 4th paragraphs as well as page 10, 2nd paragraph and claim 9, page 13).

As per **claims 2 and 7**, Snellman teaches claim 1 wherein the step of determining the corresponding first non-emergency telephone number comprises accessing a database based on the current location of the wireless handset where the database stores non-emergency telephone numbers for different locations (page 10, claim 9 teaches updating the mobile device memory with telephone number information

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based on the user's new location whereby the update signal/data is transmitted from the network, eg. a database).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
Primary Examiner

